

REMARKS/ARGUMENTS

Examiner has objected to the drawings under 37 CFR 1.83(a). With respect to this objection, the Examiner notes:

The drawings must show every feature of the invention specified in the claims. Therefore, the means for moving of claim 1, the means for sensing of claim 4, the connecting means of claim 5, the means for sensing of claim 8, the means for sensing of claim 9 must be shown or the features canceled from the claims. No new matter should be entered.

Regarding the "means for moving" of Claim 1, a retractable arm 323 has been added to Figure 7 to enhance clarity for the "means for moving" of Claim 1. This addition to the drawings is not new matter as it was fully supported and described in the specification and claims in the originally filed application. (See Page 8, Lines 11-19; Page 8, Line 30 through Page 9, Line 6; Page 9, Lines 7-16; Page 10, Lines 13-19; Page 10, Lines 20-33; and Claim 1) "In establishing a disclosure, applicant may rely not only on the description and drawing as filed but also on the original claims if their content justifies it." TMEP §608.01(l) Claim 1 states "...a means for moving said movable sensing means from an initial position into said tape path to detect said position of at least one of said takeup leader and said tape cartridge leader." In addition to Claim 1, the noted sections of the originally filed description above provide adequate support for the retractable arm 323 in the amended drawings. Applicant is conforming the drawing disclosure portion of the application to the original claims and description without introducing new matter.

Regarding the "means for sensing" of Claims 4, 8, and 9, the Examiner is directed to features light emitting sources 314 and light detecting device 316 shown in Figures 7-8.

Regarding the "connecting means" of Claim 5, a connection 121 and test fixture 120 have been added to Figure 10 to enhance clarity for the "connecting means" of Claim 5. This addition to the drawings is not new matter as it was fully supported and described in the specification and claims in the originally filed application. (See Page 9, Line 27 through Page 10, Line 4 and Claim 5) Claim 5 states "...a connecting means for removable connecting said tape drive to said test fixture...." In addition to Claim 5,

Serial No. 10/878,781

Amendment And Remarks Responsive To
Office Action Mailed 07/02/04

Page 11 of 14

298228v1

the noted section of the originally filed description above provide adequate support for the connection 121 and test fixture 120 in the amended drawings. As argued above, Applicant is conforming the drawing disclosure portion of the application to the original claims and description without introducing new matter.

Claims 1, 2, 4 – 10, and 12 – 15 have been rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. This rejection is respectfully traversed. With respect to this rejection, the Examiner notes:

For clarity and/or definiteness, it appears that a comma should be inserted after "sensing means" (claim 4, line 3, claim 10), that -in- should be inserted after "use" (claim 5, line 1), that the second "a" (claim 12, line 7) should be deleted. The following appear to lack sufficient antecedent basis (in the claim): "said movable sensing means" (claim 10). The following are not clear: "a distance...drive" (claim 7, lines 3-4). All claims should be revised carefully to correct all other deficiencies similar to the ones noted above.

Claims 4 and 10 have been amended to add a comma after "sensing means" for clarity purposes. Claim 5, line 1 has been amended to add "in" after "use" for clarity purposes. Claim 12, line 7 has been amended to delete "a" for clarity purposes. Claim 10, line 12 has been amended to delete "movable" and add "rotatable" for proper antecedent basis. Claim 7, lines 3-4 has been amended to delete "movable" from "means for sensing" and add "movably" before insertable to clarify the limitation. The limitation "a distance from a tape path with said tape drive" is similar to the limitation "a distance from a tape path" found in Claim 1, which was not objected to by the Examiner.

Claims 5, 6, and 12 – 14 have been rejected under 35 U.S.C. 102(e) as being anticipated by Zweighaft, US Patent No. 6,614,611 (hereinafter "Zweighaft"). This rejection is respectfully traversed. With respect to this rejection, the Examiner notes: "The connecting means are deemed inherent. The detecting means reads on detecting means 213 which inherently senses the positions of the leaders."

A claim is anticipated only if each and every element as set forth in the claim is found. (MPEP 2131) Independent Claim 5 is directed to a test fixture and includes the limitation of a "connecting means for removably connecting said tape drive to said test

fixture;...." The "connecting means" in this limitation provides for the connection of the test fixture to the tape drive for the testing of repeated unbuckle operations between a tape cartridge leader and a takeup leader in a laboratory environment. (See Page 9, Lines 27-31) Zweighaft does not teach or hint at connecting a test fixture to a tape drive for testing of repeated unbuckle operations. The Examiner has not cited to a page or line number that justifies the inherency rejection of this limitation. The Examiner has not provided a basis in fact and/or technical reasoning to support his findings that the allegedly inherent "connecting means" necessarily flows from Zweighaft. The limitation "connecting means" as disclosed and claimed in Applicant's application is not found or met in Zweighaft.

Further, the "detecting means 213" found in Zweighaft does not anticipate the detecting means disclosed and claimed in Applicant's application amended Claim 5. Specifically, the detecting means 213 found in Zweighaft determines the linear amount of takeup leader movement during a disconnect operation. (See Col. 5, Lines 23-39) Conversely, the detecting means disclosed and claimed in Applicant's application amended Claim 5, determines the position of at least one of a tape cartridge leader and a takeup leader within a tape path. This determination is not based on the linear amount of tape traveled during a disconnect operation, but on the position of the tape cartridge leader and a takeup leader within a tape path. (See Page 7, Line 3- through Page 8, Line 4) The limitation "detection means" as disclosed and claimed in Applicant's application is not found or met in Zweighaft. Thus, Zweighaft does not teach either the connection means or the detection means elements set forth in amended Claim 5, therefore, a prima facie case of anticipation has not been established and Claim 5 is believed to be allowable. Claim 6 depends on Claim 5 and includes all its limitations, therefore it is also believed to be allowable because it is dependent upon an allowable amended Claim 5.

Claim 12 has been amended similarly to Claim 5 to include "a tape path" and that the sensing operation takes place within the tape path. Thus, for the same reasons argued above regarding Claim 5, it is believed that amended Claim 12 is now also allowable. Further, Claims 13 and 14 depend on Claim 12 and include all its limitations, therefore they are also believed to be allowable because they are dependent upon an

allowable amended Claim 12.

Claims 5, 6, 12, and 14 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable under claims 1 – 6 of Zweighaft. This rejection is respectfully traversed. With respect to this rejection, the Examiner notes:

Claims 5, 6, 12, 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of U.S. Patent No. 6685122. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to a person having ordinary skill in the art that the claims 5, 6, 12, 14 are included in the claims 1-6 of the patent.

Applicant submits with this response a terminal disclaimer to overcome Examiner's rejection based on nonstatutory double patenting, as Applicant's application and U.S. Patent No. 6,685,122 are both commonly owned.

In light of the amendments and remarks above, Applicant believes that claims 1, 2, 4 – 10, and 12 – 15 are allowable and respectfully requests their reconsideration and allowance. The undersigned attorney requests Examiner Nguyen to telephone if a conversation could expedite prosecution. Applicant authorizes the Commissioner to charge any required fees to Deposit Account No. 50-1848.

Respectfully submitted,
PATTON BOGGS LLP

By: 

Dated: 4 October 2004

V. Craig Belair, Reg. No. 49,056
Tel: (214) 758-6631
Fax: (214) 758-1550
Customer Number 24283

Serial No. 10/678,781

Page 14 of 14

Amendment And Remarks Responsive To
Office Action Mailed 07/02/04

208228v1